

REMARKS/ARGUMENT

Claims 1, 12-13, 15-20, 22-23, 33, 35-36, 38, 40-41, 46, 48-52, and 54 are pending after entry of the present Amendment. Claims 1, 23 and 46 are herein amended to positively recite that the periodic collection of data about the plurality of computers within the peer-to-peer network is independent of any search query by a user. Claims 1, 23, and 46 are further amended to delete the language asserting that the selection of the at least one computer to be the selected computer is completed independent of the search query from the user. Support for the claim amendments is found throughout Applicants' specification as filed. Specific citations include, but are not limited to, page 8, lines 16-17: "Generally, host monitor 220 actively collects up-to-date status information on the hosts within network 100." See also, page 13, lines 4-10, describing collection daily, weekly, every 5 minutes, etc. Also on page 13, lines 19-22, describing collecting data every 5 minutes for network hubs, and less frequently for other hosts. See also page 14 describing various time intervals, and at lines 18-20 and the independence of the search query: "This allows the present invention to correctly associate a particular (set of) statistics with the proper host, *for later direction of* (for example) search queries (emphasis supplied). See also page 15, lines 1-8. Applicants respectfully submit that no new matter is introduced.

Rejections under 35 U.S.C. §103

Applicants' claims 1, 12, 23, 33, 46, 48, and 54 were rejected under 35 USC §103(a) as being unpatentable over Joffe et al. (U.S. Patent No. 6,185,619) in view of Adams (US Patent No. 6,055,568). The claim rejections are traversed, and Applicants request reconsideration in light of claim amendments and argument.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or

suggest all the claim limitations. (MPEP §2143). The mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggest the desirability of the combination. That is, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. Applicants respectfully submit a *prima facie* case of obviousness is not supported against Applicants' claimed invention.

Applicants respectfully submit that, although the office has characterized the prior art as "in the same field of endeavor," nothing has been asserted supporting a motivation to combine the references as suggested by the Office. Applicants respectfully submit that nothing in the prior art references suggests the desirability of the asserted combination, and for at least the reason that there is no motivation to combine, a *prima facie* case of obviousness is not supported, and claims 1, 12, 23, 33, 46, 48 and 54 are patentable under 35 USC §103 over the asserted combination.

Regarding Applicants' independent claims 1, 23, and 46, Applicants respectfully submit that the asserted combination fails to teach or suggest all the claim limitations as recited. Applicants have amended the claims to positively recite that the periodic collecting of data is done independent of a search query from a user. In other words, the collection of data is an on-going, continuous process that is independent of any search query by a user/participant in the peer-to-peer network. Examiner is directed to, for example, page 21, lines 7-17. Specifically, Applicants have described "the host monitor outputs its collected status information to the host selector 250. The host selector uses this data in step 415 to compile a list of, for example, ten hosts which are most likely to provide favorable search results. *Thereafter*, a user may connect to the host selector in step 420, in order to receive the list of the ten hosts" (emphasis supplied). As described, the process is on-going, continuous, and independent of a search query. Whether or not a search query is presented, the method or process described occurs. Whether or not a user connects to a host selector, the host selector has compiled the list of likely hosts.

The search methods and systems described and claimed by Applicants continuously monitor and collect data about connected computers on a periodic basis to select the best peer systems for search. The combination of references asserted by the

Office fails to teach or suggest these features. Specifically, Joffe et al. teach a method of identifying a likely content server, or priority of content servers, *in response to* a client request for data. The entire process taught by Joffe et al., some of which contains features in common with Applicants, is conducted or processed in response to each individual client request. Applicants are teaching a different process which is constant or on-going, and independent of the search query. That is, Applicants have described and claimed methods and systems in which likely servers are already identified whether or not a search query has been formulated. If a search query is formulated, the method can be further refined with more content specific information and cache, but the basic method remains independent of the search query. Even if the method of Joffe et al. is modified as asserted by the Office according to Adams, the method of Joffe et al. still teaches a search and content server identification in response to a client query. The asserted combination fails to teach each and every feature as claimed by Applicants.

Applicants have amended each of independent claims 1, 23, and 46 to positively recite these features as described above. In reply to Applicants' previous amendment, Examiner failed to address this point. While it is true that the prior art may employ "a policy," such a policy is still employed *in response to and not independent of* the search query. Applicants herein provide numerous citations from the specification as filed that describe the feature of the presently claimed invention that is clearly distinguishable and unique over the cited art. The cited art, even if there were motivation to combine, describe a stimulus-response process. The search query is a stimulus, and a network evaluation, arguably, is a response. However, the present invention describes and claims a method, system, and media, in which a peer-to-peer network is continuously and periodically monitored and evaluated independently of a user search query. The asserted combination of Joffe et al. in view of Adams fails to teach each and every element of Applicants' independent claims 1, 23, and 46, and likewise fails to teach each and every element of the dependent claims depending therefrom. Applicants submit that claims 1, 12, 23, 33, 46, 48, and 54 are patentable under 35 USC §103(a) over Joffe et al. in view of Adams. Applicants therefore respectfully request reconsideration, and withdrawal of the §103 rejections.

Claims 13, 16, 17, 19-20, 35, 38, 40-41, 49-50, and 52 were rejected under 35 USC §103(a) as being unpatentable over Joffe et al. in view of Adams in further view of Hirosawa et al. (U.S. Patent No. 6,718,391). Applicants traverse the rejections and request reconsideration.

For at least the same reasons that independent claims 1, 23, and 46 are patentable as described above, Applicants submit that claims 13, 16, 17, 19-20, 35, 38, 40-41, 49-50, and 52 are patentable under 35 USC §103(a) over Joffe et al. in view of Adams in further view of Hirosawa et al. Applicants therefore respectfully request reconsideration, and withdrawal of the §103 rejections.

Claims 18 and 36 were rejected under 35 USC §103(a) as being unpatentable over Joffe et al. in view of Adams in view of Hirosawa et al. in further view of Scharber (U.S. Patent No. 6,542,964). The rejections are traversed and Applicants request reconsideration.

For at least the same reasons that independent claims 1 and 23 are patentable as described above, Applicants submit that claims 18 and 36 are patentable under 35 USC §103(a) over Joffe et al. in view of Adams in view of Hirosawa et al. in further view of Scharber. Applicants therefore respectfully request reconsideration, and withdrawal of the §103 rejections.

Claims 15 and 51 were rejected under 35 USC §103(a) as being unpatentable over Joffe et al. in view of Adams in view of Hirosawa et al. in further view of Ishikawa et al. (JP 11015707). Applicants traverse the rejections and request reconsideration.

For at least the same reasons that independent claims 1 and 46 are patentable as described above, Applicants submit that claims 15 and 51 are patentable under 35 USC §103(a) over Joffe et al. in view of Adams in view of Hirosawa et al. in further view of Ishikawa et al. Applicants therefore respectfully request reconsideration, and withdrawal of the §103 rejections.


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Claim 22 was rejected under 35 USC §103(a) as being unpatentable over Joffe et al. in view of Adams in further view of Nagae (U.S. Patent No. 6,006,248). Applicants traverse the rejection and request reconsideration.

For at least the same reasons that independent claim 1 is patentable as described above, Applicants submit that claim 22 is patentable under 35 USC §103(a) over Joffe et al. in view of Adams in further view of Nagae. Applicants therefore respectfully request reconsideration, and withdrawal of the §103 rejections.

In view of the foregoing, Applicants respectfully request reconsideration of claims 1, 12-13, 15-20, 22-23, 33, 35-36, 38, 40-41, 46, 48-52, and 54. Applicants submit that all claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. If Examiner has any questions concerning the present Amendment, the Examiner is kindly requested to contact the undersigned at (408) 749-6900, ext. 6905. If any additional fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. NAPSP280). A copy of the transmittal is enclosed for this purpose.

Respectfully submitted,
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